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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,655	08/03/2000	Cary Lee Bates	ROC920000077US1	7024

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EXAMINER
VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/636,655	BATES ET AL.
	Examiner	**Art Unit**	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 November 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
    closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-39</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-9,11-21,23-33 and 35-39</u> is/are rejected.

7)☒ Claim(s) <u>10,22 and 34</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail. Date _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Application History

1.   This action is responsive to the applicant's submission of the Request for

Continued Examination, filed on 11/22/2004.

2.   Applicant has amended claims 10, 22, 34 and 37-39.

3.   Claims 1-39 are pending in the case; claims 1, 13 and 25 are independent

claims.

4.   Examiner's rejections of claims 10, 22 and 34, made under 35 USC 103,

as being unpatentable over McRae et al. US Patent 4,888,730 in view of

Walsh et al. US Patent 5,873,660 as recited in the previous office action

(dated 5/17/2004), are withdrawn as necessitated by the amendment of these

claims.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in

this Office action:

> *"A person shall be entitled to a patent unless –*
>
> *(b) the invention was patented or described in a printed publication in this
> or a foreign country or in public use or on sale in this country, more than
> one year prior to the date of application for patent in the United States."*

6.   Claims 1-9, 11-21, 23-33 and 35-36 remain rejected under 35
U.S.C. 102(b) as being anticipated by McRae et al. US Patent 4,888,730
(filed 1/5/1988, patented 12/19/1989). *"McRae et al."* is hereafter referred to
as *"McRae"*.

7.   **In regard to independent claim 1**, McRae discloses a computer-
implemented method for editing text in a computer text editor program.
McRae recites: *"A word-processing system having a memory, character,
format and control data input to the system through a keyboard with a plurality
of alphanumeric and function keys depressible by an operator, and a display;
in combination with at least one discrete file of editable text stored within the
memory"* (column 2, lines 38-43).

McRae discloses determining repeated terms in a section of text. McRae
recites: *"the first control causing the file to be read word-by-word and each
differentiable word to be stored in the correction buffer in association with a
respective count element therein; incrementing means for augmenting a
count in a respective count element therein, means for comparing each word
read in the file with all words stored in the correction buffer, the means for
comparing being effective to activate the incrementing means with respect to
a given count element in response to an identity between a word read in the
file and the word in the correction buffer associated with the given count
element"* (column 2, lines 49-60).

McRae discloses determining terms associated with the repeated terms
that may be used as substitute terms. McRae recites: *"it is yet another object*

of the invention to provide for indication as to which of the overused words

are available in an associated Thesaurus listing" (column 3, lines 13-15).

McRae discloses terms that are capable of being modified by user inputs.

McRae recites: *"the capability of editing stored text by modifying, relocating,*

deleting, or otherwise changing one or more words of that text" (column 1,

lines 45-48).

McRae discloses selecting one instance of one repeated term in the text;

receiving a user selection of one associated term for the repeated term; and

replacing the repeated term with the selected associated term. McRae

recites: *"it is an object of the invention to provide an improved memory*

typewriter having fast, efficient detection, display and proper guidance for

replacement of the most frequently overused words in text stored in editable

memory" (column 3, lines 3-7).

8.   **In regard to dependent claim 2**, McRae recites: *"Each pressing of a*

particular key on the typewriter's keyboard controls successive display, in

descending order of frequency, of each of the most frequently used ones of

the words" (column 3, lines 27-30).

9.   **In regard to dependent claim 3**, McRae recites: *"any line on Document*

15 can be recalled from Full-Page Correction Buffer 954C for purposes of

correcting printed text" (column 6, lines 25-27).

10.   **In regard to dependent claim 4**, McRae recites: *"Display Drivers 76*

connected to Master Microprocessor 24 by lines 74a serve to operate Display

16 (via lines 74b) for visually presenting the last plurality of character inputs in known fashion. Display 16 may be operated in conjunction with or independently of Printer 14 and is also used herein for presenting the words and counts of overused words" (column 6, lines 45-51).

11.   **In regard to dependent claim 5,** McRae recites: *"that count and the corresponding word from the selected file in Memory 842 are presented on Display 16, the count preceding the word and being separated from the latter by a space or two"* (column 8, lines 6-8).

12.   **In regard to dependent claim 6,** McRae recites: *"If the typist wants to look up synonyms of a signalled one of the overused words, a Thesaurus Program 905 is activated by pressing Code Key 21 plus the "T" Key 18T while that overused word is present on Display 16. Thesaurus List 904 is then searched for the matching word and its synonyms"* (column 8, lines 38-45). McRae also recites: *"use a known "Search and Replace" routine to replace various ones of the overused words at their different locations in the file scanned"* (column 8, lines 64-66).

13..   **In regard to dependent claim 7,** McRae recites: *"presence of a modified Dictionary List 906 containing a Special Code 907 indicating availability of synonyms in the Thesaurus program 905 for replacing words undesirably used too frequently"* (column 15, lines 61-65).

14.   **In regard to dependent claim 8**, McRae recites: *"electronic typewriters with memories storing thesauri from which a typist can select one of a succession of synonyms and retrieve it for replacement of a word"* (column 2, lines 9-12).

15.   **In regard to dependent claim 9**, the claim contains substantially the same subject matter as claims 7 and 8 combined, and remains rejected using the same rationale.

16.   **In regard to dependent claim 11**, McRae recites: *"modifying, relocating, deleting, or otherwise changing one or more words of that text"* (column 1, lines 47-48).

17.   **In regard to dependent claim 12**, McRae recites: *"provides for alerting the typist when the particular word is identical to a root word in List 904"* (column 4, lines 19-20).

18.   **In regard to claims 13-21**, the claims are directed toward a system for the method of claims 1-9, respectively, and are rejected using the same rationale.

19.   **In regard to claims 23 and 24**, the claims are directed toward a system for the method of claims 11 and 12, respectively, and are rejected using the same rationale.

20.   **In regard to independent claim 25-33**, the claims are directed toward a

program for the method of claims 1-9, respectively, and are rejected using the

same rationale.

21.   **In regard to claim 35 and 36**, the claims are directed toward a program

for the method of claims 11 and 12, respectively, and are rejected using the

same rationale.

Claim Rejections - 35 USC § 103

22.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> *"(a) A patent may not be obtained though the invention is not identically
> disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the
> prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not
> be negatived by the manner in which the invention was made."*

23.   Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable

over McRae in view of Rejndrup US Patent 6,684,221 (filed 5/8/2000,

patented 1/27/2004).

24.   **In regard to dependent claims 37**, McRae discloses determining terms

repeated in a section of text; determining terms associated with the repeated

terms that may be used as substitute terms for the repeated terms, wherein

the substitute terms are capable of being modified via user inputs; selecting

one instance of one repeated term in the text; receiving user selection of one associated term for the selected instance of the repeated term; and replacing the selected associated term for the selected instance of the repeated term in response to the user selection, as described above. McRae discloses "*a word-processing system*" (column 2, line 38), where such word-processing tools are well known to allow a user to modify any word (including substitute terms), and to add words. Also, as is well known, the modification of existing terms (including substitute terms) by a user will result in the generation of new words.

McRae fails to disclose associating the new terms with subject terms, thereby adding the new term to a predefined association group, and allowing the new term to be considered for selection. Rejndrup teaches associating the new terms with subject terms, thereby adding the new term to a predefined association group, and allowing the new term to be considered for selection. Rejndrup discloses: "*a system and method provide for accessing and updating a thesaurus*" (column 2, lines 6-7). Rejndrup describes associating new terms with a predefined association of subject terms. Rejndrup recites: "*A table of relations can be maintained to associate each clinical term with one or more related, or derived, clinical terms in the thesaurus. A clinical term can then be mapped to one or more derived terms as indicated by the relations. The derived terms can be further processed to select a preferred term from the derived terms. A set of rules can be defined to indicate the*

relations which are allowed, such as one-to-many and many-to-many" (column 2, lines 15-22).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to combine the text editor with count of overused words of McRae with the word classification and mapping system of Rejndrup in order to provide "*A thesaurus of terms employed in an industry, enterprise, or company allows terms common to the industry, enterprise, or company to associate terms with other related or equivalent terms*" (Rejndrup, column 1, lines 60-63).

25.   **In regard to claims 38 and 39**, the claims are directed toward a system or program for the method of claim 37, and are rejected using the same rationale.

Allowable Subject Matter

26.   Claims 10, 22 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

27.   Applicant's arguments filed 11/22/2004 have been fully considered but

they are not persuasive.

28.   **Regarding independent claims 1, 13 and 25,** the applicant states:

"McRae teaches away from the claim requirements because in McRae (col. 8

lines 32-33) the thesaurus list (i.e., the substitute terms) is stored in ROM. A

ROM is read only memory and cannot be modified by user inputs" (page 14,

fourth paragraph). The applicant is directed to the rejection of claims 1, 13

and 25, as restated above. In response to applicant's argument that the

references fail to show certain features of applicant's invention, it is noted that

the features upon which applicant relies (i.e., that the modification step is

implemented in the thesaurus within the ROM) are not recited in the rejected

claim(s). The limitation of claim 1 is directed toward *"substitute terms are*

capable of being modified via user inputs" and fails to distinguish where or

when the modification is performed. Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.

1993).

29.   **Regarding dependent claims 2-9, 11-12, 14-21, 23-24, 26-33 and 35-**

36, the applicant contends that the claims are allowable for at least the

reasons that claims 1, 13 and 25 are allowable. The applicant is directed to

the rejection of these claims as restated above, and to the examiner's response recited in the previous paragraph of this office action.

30.   **Regarding dependent claims 10, 22 and 34**, the applicant's arguments in response to the examiner's rejection of these claims is moot in view of the determination by the examiner that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. An objection to these claims is recited in the *Allowable Subject Matter* section of this office action.

Conclusion

31.   The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

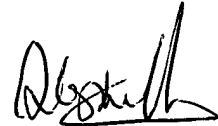| Patent	Date	Inventor
• US-5,267,156	11-1993	Nomiyama, Hiroshi
• US-6,807,545	10-2004	VanDamme, Fernand Jozef
• US-6,654,731	11-2003	Mahesh, Kavi

32.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124.

The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Gregory J. Vaughn
February 17, 2005